

Remarks/Arguments

Status of the Application

In the present response, claims 1-4, 11, 13-15 and 18 have been amended and claim 16 cancelled so that claims 1-5, 7-15, and 18-19 are pending.

Support for the amendments to claims 1-4, 11, 13-15 and 18 can be found, for example, at page 8, line 15 to page 9, line 5; page 10, lines 3-24; page 27, line 16 to page 41, line 2; and in the claims as originally filed.

In view of the Non-final Office Action at hand, Applicants representative phoned the Examiner concerning the Non-Final Office Action mailed June 20, 2008. The Examiner indicated the Non-Final Office action at hand supersedes the Non-Final Office Action mailed June 20, 2008. Applicants thank the Examiner for clarifying and note no extensions of time are due herewith as a result of such clarification.

Any amendments herein have been made without prejudice to Applicants' right to prosecute any cancelled subject matter in a timely filed continuation application.

No new matter is added.

Rejections under 35 U.S.C. §112, first paragraph

Claims 1-2, 7-11, and 13-14 stand rejected under 35 U.S.C. 112, first paragraph, "because the specification, while being enabling for pyrrole, thiazole, piperidine, and pyridine, it does not reasonably provide enablement for the broader scope in 1 claim 1 [sic] and claims dependent thereon." See, Non-final Office Action mailed August 14, 2008 (hereinafter "Office Action") at page 2.

Applicants respectfully assert the amendments provided herewith render this rejection moot. Accordingly, Applicants respectfully request the Office to withdraw this rejection.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-5 and 7-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Delorme et. al. (U.S. Pat. No. 6,187,792 or WO 98/28275). Office Action, page 5. The Office asserts Delorme et al. "teach diphenyl piperidinylidene methyl compounds corresponding to those recited in the claims for use in treating pain." *Id.* at page 6. The Office directs Applicants' attention to "column 2 lines 1+, columns 3-4, note in particular definitions A and column 5 note in particular definitions B, and,

pages 4-5.” *Id.* The Office concludes that “[s]election of these common analogous substituents would have been obvious to one of ordinary skill in the art as the resulting products would not have been unexpected.” *Id.*

Applicants respectfully assert the Office has failed to establish a *prima facie* case of obviousness because Delorme et al. do not provide any reason or motivation to make the compounds of the presently claimed invention. Indeed, the Office has failed to identify why a person of ordinary skill in the art would have been led to select and then modify the genus of Delorme et al. in the manner needed to arrive at Applicants’ claimed invention. In fact, not one of the 68 exemplified compounds of Delorme et al. contains a phenyl with a para-substituted $-C(=O)NR'R''$ group **and** a phenyl with a meta-substituted $-C(=O)NR'R''$ group. A person of ordinary skill in the art desiring to arrive at the presently claimed invention from Delorme et al.’s broad disclosure (noted by the Office as spanning columns 2-5 and pages 4-5) would have had to first select hydrogen from the two R^2 and R^3 substituents Delorme et al. indicate are substitutable on the carbons of the central piperidinyl ring. The person of ordinary skill would then have to select 4-N,N-diC₁₋₆alkylbenzamide from the vast number of possible substituents identified by Delorme et al. as possible A substituents, and further select a phenyl substituted by $-C(=O)NR'R''$ at the meta position from the numerous B substituents identified therein. Finally, the person of ordinary skill would have to select a hydrogen, C₁₋₆alkyl, substituted C₁₋₆alkyl, C₃₋₆cycloalkyl, and/or substituted C₃₋₆cycloalkyl from yet again a numerous list of R^1 groups. All of the aforementioned selections would have to be made without a single identified reason for making all the noted selections needed to arrive at the presently claimed invention.

As the Office has failed to identify any reason or motivation that would have led a person of ordinary skill in the art to select and then modify the genus of Delorme et al. in the manner needed to arrive at the compounds of the presently claimed invention, the Office has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request the Office to withdraw this rejection.

Summary

In view of the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance and respectfully solicit same. In order to expedite disposition of this case, the Office is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Although Applicants believe no fees are due, but the Commissioner is hereby authorized to charge any deficiency in fees or credit any overpayment to deposit account No. 26-0166, referencing Attorney Docket No. 101025-1P US.

Respectfully submitted,

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